

REMARKS

Upon entry of the present amendment, claims 2, 7, 8 and 10 will be amended, whereby claims 1-11 will remain pending.

Support for the amendment to the specification and claim 2 appears in Applicants' originally filed application. For example, attention is directed to Formula IB whose description is provided beginning at page 3 of the specification, with Formula IIB being a preferred embodiment of the invention relating to compound of Formula IB whose description is provided beginning at the bottom of page 3. As can be seen from a review of Formula IB, hydrogen can appear on the N as well as a 2-pyridylalkyl group. Thus, one having ordinary skill in the art reading Applicants' originally filed application would readily understand that Applicants' were in possession of hydrogen being present on the N when $r=0$ instead of the 2-pyridylalkyl group. Accordingly, the specification and claims have been amended herein to explicitly include hydrogen being present in Formula IIB when $r=0$.

Reconsideration of the rejections of record and allowance of the application are respectfully requested.

Claim of Foreign Priority

Applicants express appreciation for the acknowledgement of the claim of priority and receipt of the certified copy of the priority application.

Information Disclosure Statements

Applicants express appreciation for the Examiner's confirmation of consideration of Applicants' Information Disclosure Statements by including initialed copies of the Forms PTO-1449 with the Office Action.

Response To Restriction

The Office Action acknowledges Applicants' election with traverse of Group II, claim 1-11, formulae IB and IIIB. The Office Action indicates that claims 1-11 have been examined in part, and the requirement has been made Final.

In response, Applicants are permitting the non-elected subject matter to remain pending subject to possible rejoinder upon allowance of the elected group.

Response To Rejection Under 35 U.S.C. 112, Second Paragraph

Claims 2-4 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

The rejection contends that Formula IIB is confusing and the claims are indefinite because when $r=0$, n must have a double bond. The rejection contends that there is no acknowledgment of the double bond in the specification or claims, and its position is not identified.

In response and as discussed above, claim 2 has been amended to explicitly include that when r is 0, q is 2, and the 2-pyridylalkyl group on the nitrogen is replaced by a hydrogen atom.

Moreover, the rejection contends that claim 10 improperly depends from claim 8 as claim 10 is drawn to a kit while claim 8 is drawn to a method for measuring zinc ions.

In response, Applicants submit that claim 10 is not indefinite as a dependent claim can be directed to a different statutory class than its parent claim. However, in an attempt to advance prosecution of the application, claim 10 has been amended to be in independent form.

Accordingly, this ground of rejection should be withdrawn.

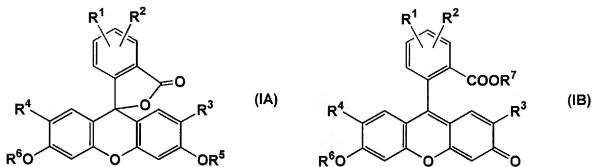
Response To Art Based Rejections

The following art based rejections are set forth in the Office Action.

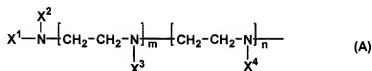
(a) Claims 1-9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagano et al., EP 1 260 510 A1 (hereinafter "Nagano")

(b) Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagano.

In response to the anticipation rejection of claims 1-9 and 11, Applicants note that independent claim 1 is directed to a compound represented by the following general formula (IA) or (IB) or a salt thereof:



wherein R¹ and R² independently represent a hydrogen atom or a group represented by the following formula (A):



wherein X^1 , X^2 , X^3 , and X^4 independently represent a hydrogen atom, a 2-pyridylmethyl group, a 2-pyridylethyl group, a 2-methyl-6-pyridylmethyl group, or a 2-methyl-6-pyridylethyl group, provided that at least one among the groups selected from the group consisting of X^1 , X^2 , X^3 , and X^4 represents a group selected from the group consisting of a 2-pyridylethyl group, a 2-methyl-6-pyridylmethyl group, and a 2-methyl-6-pyridylethyl group, and m and n independently represent 0 or 1, provided that m and n do not simultaneously represent 0; provided that R^1 and R^2 do not simultaneously represent hydrogen atoms; R^3 and R^4 independently represent a hydrogen atom or a halogen atom; R^5 and R^6 independently represent a hydrogen atom, an alkylcarbonyl group, or an alkylcarbonyloxymethyl group; and R^7 represents a hydrogen atom or an alkyl group.

Amongst other limitations included in 1, claim 1 includes, "provided that at least one among the groups selected from the group consisting of X^1 , X^2 , X^3 , and X^4 represents a group selected from the group consisting of a 2-pyridylethyl group, a 2-methyl-6-pyridylmethyl group, and a 2-methyl-6-pyridylethyl group". In this regard, the Examiner is reminded that in order to constitute an anticipatory reference, a document must include each and every feature recited in the claims.

The anticipation rejection references the *In re Petering* case, but does not address how such case is relevant to the claimed subject matter which includes at least the above-noted provision.

Accordingly, the anticipation rejection should be withdrawn for at least the reasons presented herein.

Regarding the obviousness rejection, Applicants initially submit that the claims are patentable at least for the reasons set forth above in that there is no teaching or suggest in Nagano to arrive at Applicants' claimed subject matter. This is especially the situation as one having ordinary skill in the art would not have expected at the time of Applicants' invention that the claimed compounds emit fluorescence after the compounds are bound with zinc ions.

Further, with respect to claim 8, the claim recites, amongst other features, measuring zinc ions by using two or more compounds or salts thereof selected from the recited formulas. It has been found that a wide range of zinc ion can be measured by using a combination of two or more compounds as listed in the claim. Attention is directed, for example, to Fig. 1 and the disclosure relating thereto in Applicants' specification, including the disclosure beginning at page 18.

Applicants submit that one having ordinary skill in the art would not have expected that combinations as recited in Applicants' claim 8 or in the kit recited in claim 10 can achieve measurement of zinc ions with a wide variety of concentration.

Accordingly, the rejections of record should be withdrawn.

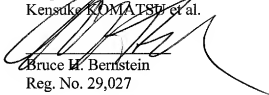
CONCLUSION

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the restriction requirement and the rejections of record, and allow each of the pending claims.

Applicants therefore respectfully request that an early indication of allowance of the application be indicated by the mailing of the Notices of Allowance and Allowability.

Should the Examiner have any questions regarding this application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully Submitted,
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